Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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**Ex parte** RICHARD A. TEDFORD, JR

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Appeal No. 2004-1805
Application No. 09/928,359

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ON BRIEF

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Before WARREN, KRATZ and PAWLIKOWSKI, **Administrative Patent Judges**.

PAWLIKOWSKI, **Administrative Patent Judge**.

## DECISION ON APPEAL

This is decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-13.

Claim 1 is representative of the subject matter on appeal and is set forth below:

> 1. A paperboard blank for forming a container, comprising:
>
> a first panel connected to a second panel along a first fold line, said second panel connected to a third panel along a second fold line, said third panel connected to a fourth panel along a third fold line, said fourth panel connected to a fifth panel along a fourth line,

> said second panel and said third panel each having a free edge,
> said fifth panel adapted to overlap said first panel to form a carton sideseam,
> said fifth panel truncated at one end, and
> a cut out in said free edge of said second panel, said cut out extending into said second panel past a line collinear [sic, colinear] with said free edge of said third panel.

On page 2 of the brief, appellant states that claims 1-13 stand or fall together. We therefore consider claim 1 in this appeal. 37 CFR § 1.192(c)(7) and (8)(2003).

Claims 1-13 stand rejected under 35 U.S.C. § 112, second paragraph (indefiniteness).

Claims 1-13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Yasui.

Claims 1-13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Derving.

The examiner relies upon the following references as evidences of unpatentability:

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| Yasui et al (Yasui) | 4,667,873 | May 26, 1987 |
| Derving | 4,702,410 | Oct. 27, 1987 |

## OPINION

### I. The 35 U.S.C. § 112, Second Paragraph Rejection (indefiniteness)

On page 3 of the answer, the examiner states that the term "cut out", recited in each of claims 1, 5, and 9, is indefinite. The examiner also concludes that the phrase recited in claim 1 regarding "a line collinear [sic, colinear] with said free edge of said third panel", is indefinite.

Appellant responds to this rejection on pages 2-3 of the brief. We have carefully reviewed appellant's position, and our determinations are set forth below.

We note that the purpose of the second paragraph of Section 112 is to basically insure, with a reasonable degree of particularity, an adequate notification of the metes and bounds of what is being claimed. See In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970).

We also note that the court stated in In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971), that the determination of whether the claims of an application satisfy the requirements of the second paragraph of Section 112 is

> To determine whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. It is here where the definiteness of language employed must be analyzed – not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. [footnote omitted.]

With regard to the claimed phrase "a line collinear [sic, colinear] with said free edge of said third panel", we refer to the paragraph bridging pages 6 and 7 of appellant's specification. Figure 5 is discussed in this paragraph. On page 6, beginning at line 36, the specification indicates that the second panel 14 illustrated in Figure 5 has a notch made from free edges 134 and 136. On page 7, at lines 2-3, the specification indicates that the free edge 134 extends from the edge 136 to the bottom of the third panel 16.

On the other hand, on page 3 of the brief, appellant states that the free edge is "an edge not attached to another portion of the carton by a fold line". Appellant states that this is the free edge that is being claimed in the phrase "a line collinear with the free edge of the third panel".

It appears that appellant's explanation conflicts with the specification as discussed above. The only disclosure of free edges in the specification is in connection with free edges 134 and 136, as discussed above. Furthermore, even if we were to use appellant's explanation that a free edge is "an edge not attached to another portion of the carton by a fold line", there are possibilities of several points of origin for such a free edge in Figure 5. Therefore, there can be multiple locations for "a line collinear with the free edge of said third panel". These multiple possible locations for such a collinear line make the claim language indefinite.

Hence, we agree with the examiner's determination that the phrase, "a line collinear [sic, colinear] with said free edge of said third panel" is indefinite.

With regard to the term "cut out", we again refer to the paragraph bridging pages 6-7 of the specification, wherein a "notch" is described with reference to Figure 5. The specification indicates that this notch is made from free edges 134, 136 as shown in Figure 5. The only place in the specification that we find the actual term "cut out" (other than in the claims), is in the Summary of the Invention, on page 3 of the specification, wherein the specification states "[t]hat portion which is cut out corresponds in form to the triangular cutout or truncated portion at the tapered end of the sideseam forming fifth panel." A dictionary definition of the term "cut out" is "something cut out or off from something else; also: the

space or hole left after cutting". See page 286 of the Merriam Webster's Collegiate Dictionary, 10th edition.

Having discussed pertinent parts of the specification and having set forth a dictionary definition, with regard to the term "cut out", we now refer to the following recitation of claim 1:

> "a cut out in said free edge of said second panel, said cut out extending into said second panel past a line collinear with said free edge of said third panel".

Because of the indefiniteness with regard to the term "free edge", and the phrase "a line collinear [sic, colinear] with said free edge of said third panel" (as discussed, supra), it is difficult to ascertain exactly where the cut out extends into the second panel past a line collinear with the free edge of the third panel. Appellant's discussion of this issue in the paragraph bridging pages 2-3 of the brief does not specifically explain where the cut out extends into the second panel past a line collinear with the free edge of the third panel. Furthermore, as discussed, supra, appellant's explanation of the phrase "a line collinear [sic, colinear] with said free edge of said third panel" does not provide the needed clarity here.

Hence, we agree with the examiner's determination that the term "cut out" is also indefinite.

In view of the above, we therefore affirm the 35 U.S.C. § 112, second paragraph rejection (indefiniteness).

II. The Anticipation Rejections

Analysis of whether a claim is patentable over the prior art under 35 USC § 102 or § 103 begins with determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art.

Because the appealed claims fail to satisfy the definiteness requirements of the second paragraph of § 112, it reasonably follows that the examiner's rejections under § 102 cannot be reached at this time.

To that end, the predecessor of our appellant reviewing court has held that it is erroneous to analyze claims based on "speculation as to the meaning of the terms employed and assumptions" as to their scope. In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA).

Consequently, in comparing the claimed subject matter with the applied art, it is apparent that considerable speculations and assumptions are necessary in order to determine what in fact is being claimed. Since a rejection based on prior art cannot be based on speculations and assumptions, we reverse, pro forma, the examiner's § 102 rejections. Id.

It is noteworthy that is a procedural reversal rather that one based upon the merits of the 35 U.S.C. § 102 rejections.

III. Conclusion

The 35 U.S.C. § 112 second paragraph rejection is **affirmed**. Each of the anticipation rejections is **reversed** on procedural grounds.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

**AFFIRMED**

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| CHARLES F. WARREN<br>Administrative Patent Judge | ) |
| PETER F. KRATZ<br>Administrative Patent Judge | ) BOARD OF PATENT APPEALS AND INTERFERENCES |
| BEVERLY A. PAWLIKOWSKI<br>Administrative Patent Judge | ) |

BAP/sld

HOFFMAN, WASSON & GITLER, P.C.
SUITE 522
2361 JEFFERSON DAVIS HIGHWAY
ARLINGTON, VA 22202